

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHILLIP B. BLANKENSHIP,
JOSEPH DRBOHLAV III and MICHAEL L. HINES

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2006-0658
Application 09/893,314

HEARD: March 23, 2006

Before WARREN, WALTZ and FRANKLIN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 CFR §41.50(a)(1) (2005); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 3, August 2005).

The sole information with respect to stability tests and fatigue tests on the record before us that is not found in appellants' specification, is in Walter and Goodrich et al. (Goodrich). Walter would have acknowledged that it was known in the art that “[h]ighway specifications are normally concerned with braking loads and reliance is primarily placed in stability tests, such as Hveem or Marshall,” and, without further explanation of either of these stability tests, that “[t]he asphalt content of the various asphaltic courses can be varied to change the stability test ratings of a composition” to avoid “problems of rutting and shoving in the surface course” and “a tendency to crack” (col. 2, ll. 52-60). Indeed, Walter would have provided no explanation of the

manner in which either the “Hveem or Marshall” stability tests are conducted and the results used to select or vary the asphalt mixtures used in various asphalt courses, and the reference does not teach the use of either of these stability tests to select asphalt mixtures for the purposes of the invention disclosed therein. In this latter respect, Walter points to *The Asphalt Handbook* (The Asphalt Institute, College Park Maryland. 1965), for the description and selection of asphalts (col. 2, ll. 19-24, and col. 6, ll. 32-45).

Goodrich would have directed one of ordinary skill in this art to determine the Beam Fatigue Life of Asphalt Concrete at 25°C using Beam Fatigue equipment operated and conducted in particular manner following certain publications (col. 11, l. 61, to col. 12, l. 35). We find no evidence in the record establishing that the particular flexibility fatigue test conducted by Goodrich would have been used by one of ordinary skill in this art to test asphalt mixtures with respect to the selection of the same for different asphalt courses for a roadway. Indeed, there is no evidence or scientific explanation in the record establishing any connection between the “fatigue cracking” in the asphalt mixtures tested by Goodrich and the problem of “a tendency to crack” acknowledged by Walter.

Thus, while it appears from the limited evidence in Walter and Goodrich that one of ordinary skill in the roadway building arts would have considered different tests to determine the suitability of asphalt mixtures for workable or optimum roadway properties with respect to various asphalt courses, including interlayer and overlay courses disclosed by Helf, the same does not constitute substantial evidence in support of the examiner’s position with respect to a Hveem Stability Test and a Flexural beam Fatigue Test, and particularly for the specific parameters required in claims 38, 39 and 55 through 59 with respect thereto. The relevancy of other tests of asphalt binder mixtures and the asphalt mixtures containing aggregate disclosed by Goodrich (e.g., col. 10, l. 60, to col. 11, l. 59) to the selection of asphalt mixtures for different asphalt courses used in roadway building, including those taught by Helf, also requires further explanation.

Appellants disclose in their specification that the Hveem Stability test to determine resistance to deformation of the compacted asphalt mixture is conducted with “the Hveem stabilimeter,” and “[p]referably, the Standard Method of Test for Resistance to Deformation and

Cohesion of Bituminous Mixtures by Means of Hveem Apparatus (AASHTO T-246 or ASTM D 1560) is performed" (page 13, [0043]). Appellants further disclose that "[f]or each climate, fatigue life of the [interlayer mixture] specimens are determined by flexural bending unit failure," and "[p]referably, the Standard Test Method for Determining the Fatigue Life of Compacted Hot Mix Asphalt (HMA) Subjected to Repeated Flexural Bending (AASHTO TP8) is performed at 2000 microstrains" (page 14, [0047]). Indeed, appellants disclose at each decision or testing point the use of an AASHTO test of the American Association of State Highway and Transportation Officials or other recognized tests which reasonably appear to be available to those of ordinary skill in this art at least at the time the present application was filed and pertinent to the art of roadway building.

We find no evidence in the official electronic files of the USPTO that recognized tests for stability and fatigue as well as other parameters specified in the appealed claims for asphalt mixtures and the components thereof for roadway construction, whether formulated by AASHTO, by other recognized organizations, or as otherwise reported in the literature were considered in the examination of this application.

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to consider the information available in the prior art with respect to stability tests, fatigue tests and other tests specified in the appealed claims for roadway building materials applicable to interlayers and overlays, such as provided by AASHTO, other recognized organizations and professional publications, and apply the developed prior art along with Helf, Walter, Goodrich, and/or McDonald art to the appealed claims, with a view toward placing this application in condition for decision on appeal with respect to the issues presented.

This remand is made for the purpose of directing the examiner to further consider the grounds of rejection. Accordingly, if the examiner submits a supplemental answer to the Board in response to this remand, "appellants must within two months from the date of the supplemental examiner's answer exercise one of" the two options set forth in 37 CFR §41.50(a)(2) (2005), "in order to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding," as provided in this rule.

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We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application, by virtue of its "special" status, requires immediate action. It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case. *See* MPEP § 708.01(D) (8th ed., Rev. 3, August 2005).

Remanded



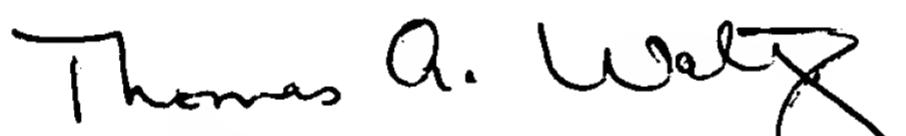
CHARLES F. WARREN

Administrative Patent Judge

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THOMAS A. WALTZ

Administrative Patent Judge

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BOARD OF PATENT

APPEALS AND

INTERFERENCES



BEVERLY A. FRANKLIN

Administrative Patent Judge

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